IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:	)	
	)	
GOLD, Stephen, et al.	)	Examiner: Dillon, S.A.
	)	
Serial No. 10/683,752	)	Group Art Unit: 2185
	)	
Filing Date: October 10, 2003	)	Conf. No.: 5052
	)	
For: PROVIDING A STATUS INDICATOR FOR A MEDIA JOB CATEGORY	)	Atty. Dkt.: 200309332-1
	)	

APPELLANTS' REPLY BRIEF

To: The Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted in response to the Examiner's Answer, paper number (unspecified), dated September 26, 2007.

RESPONSE TO EXAMINER'S ANSWER

In section 10 of the Examiner's Answer the examiner responds to the arguments made by Appellants in the Appeal Brief. Appellants reply as follows.

Re the Obviousness Rejections:

The examiner asserts that Appellants' Appeal Brief argues the "old" obviousness law (i.e., before the Supreme Court decision in *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007)).

While the ruling in *KSR* cast a new light on the obviousness issue and how obviousness is to be determined, the pending claims remain unobvious over the prior art under either the "old" analysis or the "new" the analysis presented in *KSR*.

In *KSR*, the Supreme Court affirmed that "'rejections based on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" *KSR, supra, at 1741* (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). In addition, the Court affirmed that hindsight reconstruction remains an improper basis for rejecting claims. That is, a claim "composed of several elements is not proved obvious merely by demonstration that each of its elements was, independently, known in the prior art." *KSR, supra, at 1741.*

The arguments set forth in Appellants' Appeal Brief compel a finding of non-obviousness under both the "old" and the "new" analyses. More specifically, and as argued by Appellants in the Appeal Brief, neither the teachings of the references, nor the knowledge of persons having ordinary skill in the art, are sufficient to allow the Patent Office to provide the "articulated reasoning" with "some rational underpinning" required to support its obviousness rejections. For example, in responding to Appellants' argument that the Cox reference does not describe data backup operations (much less specific issues relating to the management of media used to backup data), the examiner states (on page 8 of the Answer) that "Cox is not relied upon to describe data backup operations." Instead, the examiner states that "Cox is relied upon for describing the determination of an aggregate status from each of a set of individual statuses. . ."

The problem with this rationale is that the examiner has failed to articulate how a person having ordinary skill in the art would know to apply Cox in this way. While the examiner knows how to apply Cox, he knows so only after identifying those elements in the claims that are not in Legato. Nothing in Legato indicates the need for additional material from the Cox reference.

Indeed, because Legato mentions no need for additional status monitoring beyond that which he already discloses, a person having ordinary skill in the art, and with no knowledge of the present invention, would not view Legato as needing any additional status monitoring. While Cox provides a status of an aggregate resource, Cox makes no mention of data backup at all, much less identifies any problems or issues that would be encountered in the management of the data backup process. Because Cox is not concerned with data backup, nothing in Cox would lead a person to Legato, which involves data backup.

In summation, then, the only way a person would know to combine the various aspects of Legato and Cox would be by reference to the pending claims. However, the pending claims cannot be used as a guide to piece together the prior art, even under *KSR*. Consequently, the pending claims are allowable over Legato and Cox.

Still another problem with the examiner's obviousness rejections is that he improperly correlates terms from the prior art with terms contained in the pending claims. This improper correlation leads to a conclusion that a combination of Legato and Cox meets the limitations of the claims when, in fact, they do not. The failure to meet the limitations of the claims also means that, even under *KSR*, the claims are not obvious over Legato and Cox.

For example, in the final office action the examiner asserted that Cox's "aggregate resource" was the same as the "media job category" of the present invention. However, as argued in the Appeal Brief, the examiner's construction is not reasonable. A "category" is not a "resource" nor can a "media job category" in the pending claims be equated to Cox's "aggregate resource." Improperly equating terms is neither "reasonable" nor "rational" under *KSR*.

The next issue raised by the examiner relates to the nature of the status indicators of both the present invention and by the Cox reference. More specifically, Appellants point out that the "status indicator" of the present invention is inherently "backward-looking and performance-

based," whereas the "status" of Cox is inherently "forward-looking and capacity related." The examiner rejects this distinction because the term is not contained in the claim or the specification. The examiner's rejection is improper because the distinctions are inherent in both the present invention and in Cox, thus can be used to distinguish the two inventions.

The "status" provided by Cox is forward-looking and capacity related because of the way in which Cox uses the term. The Cox reference is concerned with "the problem of maintaining an accurate awareness of the status of logical or aggregate resources in a communications network, (col. 1, lines 21-24) so that an estimation can be made of the ability of an aggregate resource to function now and in the future. In assessing the prior art solutions, Cox specifically states that prior art solutions do "not provide any means of calculating the actual status" and give "only a gross indication of the potential operative or inoperative status, not a real assessment of actual condition." See, for example, col. 1, lines 36-43 of Cox. Clearly, then, the "status" of Cox's "aggregate resource" relates to the current ability of the aggregate resource to perform its intended function, and at what capacity. That is, Cox's status is inherently forward-looking and capacity related.

In contrast, the "status indicator" provided by the present invention is inherently backward-looking and performance based. While these exact words are not in the specification or claims, the specification describes the "status indicator" as being indicative of the past performance of the media job, i.e., whether the media job met a targeted performance level. If it did, then the status indicator so indicates. Similarly, the status indicator will also indicate when the service level objective was not met. Simply stated, the "status indicator" of the present invention is inherently backward-looking and performance-based.

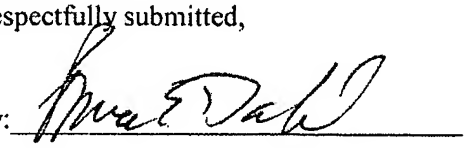
Because these two different characterizations are inherent in the "status" of Cox and the "status indicator" of the present invention, they can be used to distinguish the present invention

from Cox. Ignoring these distinctions when they are inherent in the claim terms cannot form the basis for an obviousness rejection.

Conclusion:

The examiner's obviousness rejections are improper because he has failed to establish an "articulated reason" with "some rational underpinning" as to why a person having ordinary skill in the art would know to combine Legato and Cox. That is, the examiner has failed to meet the obviousness test articulated by *KSR*. Moreover, even if such an articulated reason and rational underpinning could be provided, the resulting combination still would fail to make obvious the pending claims because the "status" provided by Cox is not the same as the "status indicator" in the pending claims and because Cox's "aggregate resource" is not a "media job category." Therefore, Appellants respectfully request the Board to reverse the rejections of claims 1-20.

Respectfully submitted,

By: 

Bruce E. Dahl, Esq.
Attorney for Appellant
PTO Registration No. 33,670
FENNEMORE CRAIG, P.C.
1700 Lincoln Street, Suite 2625
Denver, CO 80203
(303) 291-3200

Date: 11-7-07